

### Remarks

Attached is a terminal disclaimer over the Curcio et al Patent No. 6,465,084 B1 and a declaration as suggested by the examiner. Therefore, the rejection under 35 U.S.C. § 103(a) using Curcio et al as a reference is believed to be overcome.

The examiner has rejected claims 1-9 as being unpatentable over Kariya (WO 01/42006) hereinafter Kariya, in view of Bross et al (U.S. Patent 5,517,571), hereinafter Bross et al. This rejection is not thought to be well taken, especially with the amendments to claim 1, incorporating the subject matter of claim 2 therein. Since claim 2 has been incorporated in claim 1, and claim 2 has been cancelled, the comments following regarding claim 1 are all directed to the examiner's rejection of claim 2, and the remaining claims now depend directly or indirectly from claim 1 as amended.

The examiner states that "...Kariya teaches providing separate adhesive sheets (Column 8, line 67 to Column 9, line 2)". Applicants respectfully disagree with this reading of the location cited (U.S. Patent No. 6,440,542 B1). The location cited by the examiner states:

"...however the present invention is not limited and that the adhesive layer 22 may be provided during stacking of the single-sided circuit boards on each other."

Thus, all that Kariya does is state *when* the adhesive is applied, not the *form* in which it is applied. Indeed, the Kariya reference is silent as to any form of separate adhesive sheet.

It is not enough that one may modify a reference in view of a second reference, but rather it is required that the second reference suggest modification of the first reference and not merely provide the capability of modifying the first reference.

The CAFC stated In re Piasecki, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

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The Supreme Court in Graham v. John Deere Co., 383 U.S. 1 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under Section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103". Citing In re Warner, 379 F.2d 1011, 1020, 154 USPQ 173, 177 (CCPA 1967).

The law is quite clear that in order for a claimed invention to be rejected on obviousness, the prior art must suggest the modifications sought to be patented; In re Gordon, 221 U.S.P.Q. 1125, 1127 (CAFC 1984); ACS Hospital System, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (CAFC 1984). The foregoing principle of law has been followed in Aqua-Aerobic Systems, Inc. v. Richards of Rockford, Inc., 1 U.S.P.Q. 2d, 1945 (D.C. Illinois 1986). In the Aqua-Aerobic's case, the Court stated that the fact that a prior reference can be modified to show the claimed invention does not make the modification obvious unless the prior reference suggests the desirability of the modification. The CAFC in the case of In re Gorman, 18 U.S.P.Q. 2d (CAFC 1991) held at page 1888:

"When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant [citation]. 'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination [citations]. . .

The references themselves must provide some teaching whereby the applicant's combination would have been obvious."

Further, the CAFC, in In re Oetiker, 24 U.S.P.Q. 2nd 1443, 1445 (CAFC 1992) held:

There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.

Most significantly, the CAFC in the recent case of In re Dembiczak, 50 U.S.P.Q.2<sup>nd</sup> 1614 (CAFC 1999) held at 1617:

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...(examiner can satisfy burden of obviousness in light of combination 'only by showing some objective teaching [leading to the combination]');

Thus, it is clear that where an individual reference does not teach the entire invention, then the modification which the invention represents must be suggested and motivated by some other reference through some objective teaching and cannot come from the application itself, which is not the case here.

As pointed out above, Kariya does not suggest separate sheets of adhesive and Bross et al do not overcome this defect. Indeed, Bross et al talk about an organic coating on the sheets forming the adhesive, not separate sheets of adhesive (Column 8, lines 48-53). Thus, it is believed that claim 1 as amended is clearly allowable over any reasonable combination of Kariya and Bross et al.

Claims 3-9 are dependent upon claim 1, either directly or indirectly, and, for the same reasons, are believed to be allowable.

Moreover, claims 3 and 5 require the vias be plated. This is not taught nor suggested by either of the references as admitted by the examiner. While this may be conventional in other applications, there is nothing to suggest it in this application. Again, it is pointed out that if a reference does not show a particular feature, this feature must be in some other reference, *and* this other reference must suggest it in the combination, which is not the case here. Claim 6 requires partial cure of the resin. This is not taught nor suggested by either reference, nor is it apparent why it would be obvious here. Thus, for these additional reasons, claims 3, 5 and 6 are believed to be allowable.

The examiner has rejected claims 1-9 under 35 U.S.C. § 103 (a) as being unpatentable over St. John (U.S. Patent 6,337,037), hereinafter St. John, in view of Bross et al and either Pommer (U.S. Patent 6,560,884), hereinafter Pommer, or Kariya. This rejection is not thought to be well

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taken. First, the examiner admits that St. John does not teach separate adhesive sheets between layers and, as pointed out above, neither Bross et al nor Kariya overcomes this deficiency. Also Pommer, which shows only alignment openings, does not overcome this deficiency. Thus, claim 1 and claims 3-9 are allowable there over.


In view of the above, reconsideration and allowance of amended claim 1 and dependent claims 3-9 is respectfully requested.

Respectfully submitted,

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Enclosures

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